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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,895	09/23/2003	Zvonimir Z. Bandic	HSJ920030180US2	2521

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EXAMINER

DATSKOVSKIY, MICHAEL V

ART UNIT PAPER NUMBER

2835

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,895

Applicant(s)

BANDIC ET AL.

Examiner

Michael V. Datskovskiy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 2 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "a retrograde-looking design" in claim 2 is a relative term, which renders the claim indefinite. The term "a retrograde-looking design" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Generally, an appearance design of a product is a subject of a "Design Patent".

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: The parent claim 1 claims a cover as a part of a hard disk drive. Hence, it cannot be simultaneously an integral part of an electronic device and of a hard disk drive. According to the paragraph [0030] of the specification: "the cover of the disk drive may be formed as an integral part of the cover of the whole machine, such as the electronic device 603. Thus, the cover can be either a part of a hard disk drive or a part of an electronic system

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(computer) comprising said hard disk. Hence, claim 10 contradicts the parent claim 1 and the description.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 6-7, 9-11 (claim 10 as best understood by examiner) are rejected under 35 U.S.C. 102(e) as being anticipated by Huang (US Patent Application Publication 2002/0186529A1).

Huang teaches an electronic system, Fig. 2, comprising: an electronic device-notebook 100; a hard disk drive 114 mounted into said notebook, wherein said hard disk and said notebook are each designed having transparent covers allowing direct observation of rotating parts of the hard disk drive. It is inherent that said transparent windows are provided with opaque frames reinforcing them. (See paragraphs [0015], [0016], [0017] and also claim 5).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-5, 8 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang.

Regarding to claims 2-5: Huang teaches all limitations of the claims except said electronic device is a desktop computer (claim 2) or an MP3 player (claim 3) or a pocket PC (claim 4) or a mobile telephone (claim 5). It would have been obvious to one ordinary skilled in the art at the time invention was made to use transparent covers as they are shown by Huang for observing interior rotating parts in any of these electronic devices, since a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding to claims 8 and 15-17: Huang teaches all limitations of the claims except said cover is tinted with a color, or said electronic system further comprising decorations causing appearance of color, and change and movement of color depending on an angle of observation; or comprising a pattern decoration, wherein said pattern decoration is a diffraction pattern. It would have been obvious to one ordinary skilled in the art at the time invention was made to alter the color of the cover or the patterns of the elements of the disk drive in the device by Huang, since it has been held

that it is well within the purview of a skilled artisan and absent an unobvious result, because the change of color or pattern, which is applicable and analogous to printed matter and the differences of printed matter (i.e. color, patterns decorations) cannot afford a basis for different patents. See *Ex Parte S*, 25 J.P.Q.S. (Bd. Ap. 1943).

9. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang as applied to claims above, and further in view of Miyashita (JP02001210005A). Huang teaches all limitations of the claims except said system further comprising a flashing device (stroboscope) mounted to the housing for making movement inside the housing appear to move at a speed that is less than an actual speed of the movement. Teaches an optical disk drive comprising a flashing device (stroboscope) mounted to the housing of the disk drive. It would have been obvious to one ordinary skilled in the art at the time invention was made to employ a stroboscope in the device by Huang as it is shown by Miyashita, in order to enhance accuracy of the observation of the rotating parts of the disk drive.

Double Patenting

10. Claims 1, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16 and 17 of this application conflict with claims 1 (claim 1); 2 (claim 6); 3 (claim 7); 4 (claim 8); 5 (claim 9); 6 (claim 11); 7 (claim 12); 8 (claim 13); 9 (claim 14); 10 (claim 15); 11 (claim 16) and 12 (claim 17) of Application No. 10/668,624 (US Patent Application Publication 2005/0063090 A1). 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during

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pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

11. Claims 1 and 6-17 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of respective claims 1-12 of copending Application No. 10/668,624. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Dowling et al (US Patent 6,888,322); Huang (US Patent 6,891,721) and Shih-Tsung (US Patent Application Publication 2004/0052042 A1).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Datskovskiy whose telephone number is (571) 272-2040. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on (571) 272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Michael V Datskovskiy".

Michael V Datskovskiy
Primary Examiner
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08/17/2005